PATENT

Docket No. RSW9-99-107

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

INVENTORS: **Daniel R. Drake, John McGarvey, Steven Miller and Robert Leah**

APPL. NO.   **09/921,504**   Examiner: **C. Kendall**
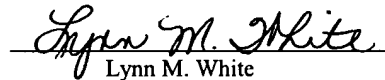
FILED: **August 2, 2001**   Art Unit: **2122**

CASE: **RSW92001005US1**

TITLE: **METHOD AND COMPUTER PROGRAM PRODUCT FOR INTEGRATING NON-REDISTRIBUTABLE SOFTWARE APPLICATIONS IN A CUSTOMER DRIVEN INSTALLABLE PACKAGE**

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Attention: Board of Patent Appeals and Interferences

APPELLANTS' BRIEF

This brief is in furtherance of the Notice of Appeal filed in this case on May 10, 2005.

This brief is transmitted in triplicate. The requisite fee ($500.00) set forth in §1.17(f) is authorized to be charged to Deposit Account No. 09-0461.

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1.   REAL PARTY IN INTEREST

The present application is assigned to International Business Machines

Corporation, having its principal place of business at New Orchard Road, Armonk, New York

10504. Accordingly, International Business Machines Corporation is the real party in interest.

2.   RELATED APPEALS AND INTERFERENCES

Applicant is unaware of any appeals or interferences which may be related to or

directly affect the Board's decision in the pending appeal.

3.   STATUS OF CLAIMS

A.   Claims canceled: 1-14, 16-20, and 22-28

B.   Claims withdrawn from consideration but not canceled: None

C.   Claims pending: 15 and 21

D.   Claims allowed: none

E.   Claims rejected: 15 and 21

F.   Claims appealed: 15 and 21

Appealed claims 15 and 21 as currently pending are attached as Appendix A

hereto.

4.   STATUS OF AMENDMENTS

An amendment after final was filed in the present case on April 11, 2005. A Reply

under 37 C.F.R. §1.111 was filed on July 22, 2004 and resulted in the final Office Action

appealed herein. A first Advisory Action was mailed on July 5, 2005, and a second Advisory

Action was faxed on August 23, 2005. A Notice of Appeal was filed on May 10, 2005.

5.   SUMMARY OF THE CLAIMED SUBJECT MATTER

Claim 15: A system of integrating the installation, on one or more target machines, of

software prerequisites with a to-be-installed (TBI) software application, comprising: means for

determining if said TBI software application requires any software prerequisites (*page 6, lines 5-*

7); means for obtaining location information for all required software prerequisites (*page 6, lines*

9-14); means for creating a super image comprising the TBI software application wrapped with

the location information for said software prerequisites (*page 6, line 15-page 7, line 2*); and

means for distributing said super image to all machines on which said software application is to

be installed (*page 7, lines 3-4*); wherein: said means for creating a super image comprises at

least: means for defining an object model representing the integrated software installation (*page*

6, line 19-page 7, line 2); means for populating the object model with attributes and method to

describe the TBI software application and the location information for said software prerequisites

(*page 6, line 19-page 7, line 2*); and means for instantiating one or more objects according to the

defined object model, whereby said means for instantiating instantiates an object for the TBI

software application and one or more component objects for each of said prerequisites and said

populating step populates the instantiated object(s) (*page 6, line 19-page 7, line 2*); and wherein

said system further comprises means for using the populated object model to install the TBI

software application, said means for using the populated object model further comprises at least:

means for identifying one or more target machines on which the TBI software application is to

be installed (*page 6, line 19-page 7, line 2*); means for downloading the super image to the

identified target machines (*page 6, line 19-page 7, line 2*); and means for performing an

installation at each of the identified target machines using the downloaded super image (*page 6,
line 19-page 7, line 2*).

Claim 15 is a means-plus-function claim and the structure and acts corresponding to the

claimed function are found at page 8, line 19 through page 14, line 15.

The present invention relates to an improved system for installation of to-be-installed

("TBI") software packages and any software prerequisites needed to install and/or run the TBI

software. In accordance with the present invention, an installation wizard is provided having

panels that prompt a user to identify a location where a software prerequisite can be found prior

to installing the TBI software. The wizard can optionally allow for the finding and inclusion of

file locations via a standard file browse dialog or via a URL. The prerequisite information is

then fully integrated into the install process as part of a "super image" that is transferred to one or

more target devices. Each target device then executes the super image to install the TBI software

and the prerequisites. From the perspective of the installer, the installation proceeds seamlessly

and without interruption. The present invention essentially allows the temporary "virtual

bundling" of licensed software and non-redistributable software prerequisites into a single

installation that appears seamless to an end user.

6.   **GROUNDS OF REJECTION TO REVIEWED ON APPEAL**

Applicant requests the Board to review the rejection of the claims under 35 U.S.C. §103

based on U.S. Patent No. 5,867,713 to Shrader et al. in view of U.S. Patent No. 6,353,926 to

Parathesarathy et al.

7.   **ARGUMENT**

A.   **The Examiner has not Established a *prima facie* Case of Obviousness**

As set forth in the MPEP:

> To establish a *prima facie* case of obviousness, there must be some suggestion or
> motivation, either in the references themselves or in the knowledge generally
> available to one of ordinary skilled in the art, to modify the reference or to combine
> reference teachings.
> MPEP 2143

B.   **Claims 15 and 21**

Applicant has canceled claims 1-14, 16-20, and 22-28 and has amended independent claim 15

to include all of the limitations of claims 16-20. Thus, the present claimed invention not only claims

the "super image" but also includes the specific means for creating the super image and means for

using a populated object model to install the TBI software application. Further, the present claimed

invention includes means for instantiating one or more objects according to the defined object model,

whereby an object for the TBI software application and one or more component objects for each of

the prerequisites are instantiated. As explained in the specification of the present application, what this means is that the location information of the software prerequisite is essentially bundled ("virtually bundled") with the TBI software application, and the prerequisite itself can be virtually bundled with the TBI software application as well. Thus, prerequisites which are non-redistributable, i.e., they are made available for use by cannot be bundled with the TBI software application, can be virtually bundled so that they may be used, and then deleted, thereby not raising any software licensing issues.

E.   General Discussion

U.S. Patent No. 5,867,713 to Shrader et al. ("Shrader") teaches a mechanism for installing applications in a network. Of relevance to the present invention is the mechanism by which prerequisite files are validated, and added when missing. If a scan of file directories indicates the presence of a prerequisite, the system assumes the prerequisite is there, even though it might not be (e.g., there could be a directory which might indicate the presence of a prerequisite, but the files that should be in the directory might be missing). Further, when prerequisites are found to be missing from the target machine, they are served to the target machine based on install operations executed by the network installation engine, not by the target machine.

U.S. Patent No. 6,353,926 to Parathesarathy et al. ("Parathesarathy") teaches a method for allowing a software vendor to notify a user of a software update. A user subscribes to a "software update channel" and a shortcut link is created that identifies the application(s) to be upgraded. When a new update is detected, the software channel delivers the software update to

the user's computer. The Examiner relies upon Parathesarathy for an alleged teaching of the

inclusion of location information of software prerequisites as part of the information provided by

the software update channel.

Neither Shrader nor Parathesarathy teach nor suggest the obtaining of location

information for the software prerequisites and the inclusion of this location information as part of

a super image that is delivered to the local machines for installation with the super image being

created in the claimed manner. Further, since they do not teach or suggest the formation of the

super image, they do not teach or suggest the claimed means for creating the super image.

The Examiner states that column 8, lines 45-50 of Shrader:

"…discloses an Application image (AppImage) objects, 254 and 258 represent
product images which has a link to an Application object in the Application
Container Object, the link points to another object in the Network installation
program. Examiner interprets the AppImage to be the super image and the link
which it contains, that points to another object in the installations plan to be the
location or address of a needed file or prerequisite object as claimed by
Applicant."

The portion of Shrader relied upon by the Examiner does not teach or suggest the claimed

super image. In Shrader, the AppImage is stored on the Code Server not on the local machine.

All of the operations are "pushed" from the Code Server, and the execution of the delivery of the

software prerequisites is performed by the network installation machine, not by the local

machines as claimed herein.

By having the capability to identify and include location information for the prerequisites

prior to delivery of the super image to the local machine(s), the seamless installation process

described above is possible. Such a seamless installation process is not possible using the

Shrader system, the Parathesarathy system, nor any combination thereof. Accordingly,

independent claim 15, and all claims depending therefrom, patentably define over Shrader and

Parathesarathy and are in condition for allowance.

8. CONCLUSION

For the foregoing reasons applicants respectfully request this Board to overrule the

Examiner's rejections and allow claims 15 and 21.

Respectfully submitted:

September 12, 2005
Date

Mark D. Simpson, Reg. No. 32,942
Synnestvedt & Lechner LLP
2600 Aramark Tower
1101 Market Street
Philadelphia, PA 19107
Telephone: 215-923-4466
Facsimile: 215-923-2189

CLAIMS APPENDIX

CLAIMS INVOLVED IN THIS APPEAL:

Claims 1-14 (Canceled)

15. (Previously presented) A system of integrating the installation, on one or more target machines, of software prerequisites with a to-be-installed (TBI) software application, comprising:

means for determining if said TBI software application requires any software prerequisites;

means for obtaining location information for all required software prerequisites;

means for creating a super image comprising the TBI software application wrapped with the location information for said software prerequisites; and

means for distributing said super image to all machines on which said software application is to be installed; wherein:

said means for creating a super image comprises at least:

means for defining an object model representing the integrated software installation;

means for populating the object model with attributes and method to describe the TBI software application and the location information for said software prerequisites; and

means for instantiating one or more objects according to the defined object model, whereby said means for instantiating instantiates an object for the TBI software application and one or more component objects for each of said prerequisites and said populating step populates the instantiated object(s);

and wherein said system further comprises means for using the populated object model to install the TBI software application, said means for using the populated object model further comprises at least:

means for identifying one or more target machines on which the TBI software application is to be installed;

means for downloading the super image to the identified target machines; and

means for performing an installation at each of the identified target machines using the downloaded super image.

Claims 16-20 (Canceled)

21. (Original) A system as set forth in claim 15, wherein said super image is a temporary file that is deleted from said target machines upon completion of the installation process.

Claims 22-28 (Canceled)

EVIDENCE APPENDIX

No additional evidence is presented.

RELATED PROCEEDINGS APPENDIX

No additional related proceedings are presented.